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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
FUJS 15.541(100794-11066)

I hereby certify that this paper is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 pursuant to 37 CFR 1.10 on the date shown below

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Application Number	Filed
09/179,156	10/26/1998

First Named Inventor
Hideki WATANABE

Art Unit	Examiner
2617	Naghmeh MEHRPOUR

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record. Registration number 51,271

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/Brian E. Hennessey/
Signature

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09-24-2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

Attorney Docket No.: FUJS 15.541 (100794-11066)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor:	Hideki WATANABE
Serial No.:	09/179,156
Filed:	October 26, 1998
Title:	**RADIO RECEIVER AND SIGNAL AMPLIFYING METHOD IN RADIO RECEIVER**
Examiner:	Naghmeh Mehrpour
Group Art Unit:	2617
Confirmation No.:	5362

September 24, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ARGUMENTS SUBMITTED IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

This communication is filed with and in support of a Pre-Appeal Brief Request for Review, requesting a panel review to determine whether the Examiner has established a prima facie case of unpatentability with respect to pending claims 1-16 and 34.

Claim 1 relates to a radio receiver that includes, *inter alia*, plural types of amplifiers, each of which corresponds to one of said radio communication modes, each amplifier amplifying a received signal according to said corresponding radio communication mode***, and having a transistor and a resistance connected to an emitter of the transistor, and each of the resistances has a different resistance value***. The radio receiver of claim 1 also includes a bias current controlling unit controlling a plurality of

bias currents, each of the bias currents being provided for a corresponding amplifier when said control unit performs the selecting of the respective waiting mode, each of the bias currents being different from each other bias current ***due to a difference of the resistance values***.

Claims 1-16 and 34 are pending in the application. Claims 1-3, 11-16, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,309,502 to Hirai (hereinafter referred to as Hirai) and United States Patent No. 6,069,525 to Sevic et al. (hereinafter referred to as Sevic). Applicants respectfully traverse.

The Office Action maintains that Sevic discloses a plurality of amplifiers, each having "a transistor and a resistance connected to an emitter of the transmitter, and each of the resistances has a different resistance value" (Office Action; page 3, lines 2-4; citing Sevic; col. 2, line 50, to col. 3, line 17). However, the cited section apparently discloses only the summary of the disclosure of Sevic, including a variable supply voltage for an amplifier and a plurality of transistor stages. ***There is no indication in Sevic relating to a resistance connected to an emitter of the transistors, nor that each of the resistances is different from each other resistance***.

The Office Action further asserts that it is inherently disclosed in Sevic that each of the resistances is different and that this causes each of the bias currents to be different from each other bias current (Office Action; page 9, lines 14-15). However, the Office Action's inherency argument is clearly flawed, since ***inherency requires that the feature necessarily follows from the disclosed structure or method*** (MPEP 2163.07(a) relating to Inherent Function, Theory, or Advantage). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing

described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. ***The mere fact that a certain thing may result from a given set of circumstances is not sufficient***.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted; emphasis added). In stark contrast, the Office Action asserts that "different stages of the transistor [] ***usually*** have different resistors" (Office Action; page 9; lines 15-17; emphasis added). Therefore, it is not ***necessary*** that each transistor have a different resistor, and therefore such a structure is not ***inherent*** in Sevic. Therefore, none of the references disclose or suggest, either explicitly or inherently, this feature of the claims as presented.

Claims 2, 3, and 11-16 each depend directly or indirectly from claim 1, and are therefore allowable for at least the same reasons as claim 1 is allowable.

Claim 34 relates to a signal amplifying method in a radio receiver for receiving a radio signal according to plural types of radio communication modes, each radio communication mode dealing with a radio signal having a different power-density spectrum. The method of claim 34 includes, *inter alia*, selecting by said control unit one of plural types of amplifiers, each of which corresponds to one of said radio communication modes, said selected amplifier corresponding to the selected waiting mode which in turn corresponds to said one of said plural types of radio communication modes, ***and having a transistor and a resistance connected to an emitter of the transistor, and each of the resistances has a different resistance value***. The method of claim 34 also includes controlling a plurality of bias currents, each of the bias currents being provided for a corresponding amplifier when said control unit performs the selecting of the respective

waiting mode, each of the bias currents being different from each other bias current ***due to a difference of the resistance values***.

Therefore, for at least the same reasons as claim 1 is allowable, claim 34 is also allowable.

Claims 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirai and Sevic in view of United States Patent No. 5,930,692 to Peterzell et al. (hereinafter referred to as Peterzell). Applicants respectfully traverse.

Claims 4-10 each depend directly or indirectly from claim 1, and are therefore allowable for at least the same reasons as claim 1 is allowable.

Additionally, claim 4 recites that said ***output selection portion*** is provided at an intermediate frequency stage where a radio signal of intermediate frequency band after a radio signal of radio frequency band is down-converted is entered as said received signal, and said amplifiers are each constructed as one adapted for intermediate frequency band which amplifies said radio signal of intermediate frequency band. Regarding claim 4, the Office Action asserts that Peterzell discloses a radio receiver wherein the output selection portion is entered to the down converter IF mixer 705 (Office Action; page 6, lines 8-10; citing Figure 7; and col. 6; lines 34-42). However, Figure 7 of Peterzell does not disclose an output selection portion, and only apparently discloses that the signals from IF mixer 705 are inputted to both of amplifiers 708 and 709, ***without being selected***. Therefore, each of Sevic, Hirai, and Peterzell fails to disclose or suggest the subject matter of claim 4, and in the absence of a considerable reconstruction to the cited references, any expert in the art would not reach the subject matter recited in claim 4.

In view of the remarks set forth above, this application is believed to be in

condition for allowance, which action is respectfully requested. Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,

/Brian Hennessey/

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